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EXAMINER
LE, DANH C

ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 03/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/343,823	BYERS ET AL.	
	Examiner	Art Unit	
	DANH C LE	2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,10-14 and 18-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,10-14 and 18-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This office action is responsive to the communication 01-04-02.

2. Claims 8-9, 15-17 have been cancelled. Claims 1-7, 10-14 and 18-32 remain in prosecution.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, 7, 18-21, 23, 25-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Liao et al (US 6,292,838).

As to claim1, Liao teaches a telecommunications network (figure 1) comprising:

an originating system (108) connected to a terminating system (106) via at least one other network element (104); and

a network element (104) equipped with a processor (col.4, lines 38-40) for transmitting a message to the terminating system (106) indicating that a transmission was received over a non private link subject to unauthorized interception (col.11, lines 20-40). On figure 1, Liao discloses the interface between Network Gateway (104) and mobile device is connected over the non private link (a public network, col.4, lines 27-37), Liao also discloses a transmission over a public network being intercepted or altered (col.6, lines 10-14).

As to claim 2, Liao teaches the telecommunications network of claim 1 further comprising the terminating system alerting a called station that the transmission was non-private upon receipt of the insecure message (col.11, lines 20-40).

As to claim 3, Liao teaches a telecommunications network of claim 1 further comprising the originating system alerting a calling party of the presence of the non private link (col.11, lines 34-40).

As to claim 4, Liao teaches a method for providing secure transmissions in a telecommunications network (figure 1) comprising the steps of:

establishing a route from a sender (100) to a recipient (102);

determining whether at least a portion of the route includes an insecure link (figure 5, 510); and

responsive to determination that the route includes an insecure link provide to the sender and prior to connection to the recipient an alert of the insecure nature of the transmission (col.11, lines 20-40). On figure 5, Liao teaches when the decision block determines that the connection is not secure, a secure indicator is reset 512 to insecure

and forward message to the requesting mobile device indicating the link is insecure prior connecting to the server (col.11, lines 13-40).

As to claim 5, Liao teaches the method of claim 4 further comprising the step of: completing a call after the alert has been provided (figure 5, steps 510-516).

As to claim 7, Liao teaches the method of claim 4 wherein providing an alert includes issuing a message on an identification display (col.3, lines 4-11).

As to claim 18, Liao teaches telecommunications system (figure 1) comprising: means for interconnecting a caller to a called party (102,110); and

means for alerting the caller or called party when a call path is using at least one insecure link (figure 5, 512 or col.11, lines 12-16). On figure 5, Liao teaches a decision block 510 determines whether the connection being utilized is secure or insecure concerning the connection from the mobile device to the remote server or some portion thereof, when the decision block determines that the connection is not secure, a secure indicator is reset 512 to insecure indicator and forward message to requesting mobile device indicating that the calling path is using at least one insecure link (col.11, lines 13-40).

As to claim 19, Liao teaches the telecommunications system of claim 18 wherein the call path traverses a packet data network (col.4, lines 38-40).

As to claim 20, Liao teaches the telecommunications system of claim 18 further comprising means for determining whether an insecure link has been traversed (col.11, lines 16-20).

As to claims 21, Liao teaches the telecommunications system on claim 18 further comprising means for issuing insecure link alert signals to other elements in a telecommunications network (col.11, lines 16-28).

As to claim 23, Liao teaches the telecommunications system of claim 18 wherein the call path traverses a cell network (figure 1).

As to claim 25, Liao teaches a method for providing secure transmissions in a telecommunications network (figure 1) comprising the steps of:

establishing a route from a sender to a recipient (a router from mobile 102 to remote server 110);

determining whether at least a portion of the route includes a non-private link subject to unauthorized interception (a indicate message forward to the mobile device, step 516 of figure 5);

responsive to a positive result in said determining step, further determining whether a secure connection may be established between said sender and said recipient (a secure indicator message forward to requesting mobile device at steps 510, 514, 516 of figure 5); and

responsive to a positive result in said determining step and a negative result in said further determining step, providing an alert of the insecure nature of the route (a insecure indicator message forward to requesting mobile device step 512, 516 of figure 5).

As to claims 26-27, Liao teaches the method of claim 25 wherein said telecommunications network includes at least one intermediate node in said route from said sender to said recipient, and wherein step c. thereof further comprises the step of:

transmitting a message including a security status request through each of said at least one intermediate node (Figure 6, shows a message including status request transmit from network gateway 612 through carrier network 614 to mobile device 616). Liao also teaches a message can be instead be supplied to the network gateway by remote server (intermediate node, step 503 of figure 5), if such node is insecure, receiving a message indicating such node is insecure (steps 512, 516 of figure 5).

As to claim 28, Liao teaches the method of claim 25 further comprising the step of:

establishing a secure connection between said sender and said recipient (Liao teaches as soon as the secure connection is establishes down load authorized service identities from network gateway, figure 2).

As to claim 29, liao teaches the method of claim 25 further comprising the step of:

establishing a connection between said sender and said recipient despite a determination that a secure connection cannot be established. Liao teaches that after receiving the secure indicator that a secure connection cannot be established, the mobile still connects to the server to process the data (col.11, lines 13-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 6,10-12,14, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liao in view of Zicker et al (US 5,862,475).

As to claims 6, 10-12,14, 22 and 24, Liao teaches a method for providing security transmissions in communication network on claim 4 above. Liao fails to teach an alert in the system above including a distinctive ring at the recipient's station, an audible voice message, an audible tone, providing a periodic alert, a query screen on a personal computer, warning signals throughout the call and special parameters for a particular subscriber. Zicker teaches an alert in the system above including a distinctive

ring (col.3, 13-20) at the recipient's station, an audible voice message (co.39, lines 42-47), an audible tone (col.40, lines 57-62), providing a periodic alert (col.14, lines 34-38), a query screen (col.24, lines 35-44) on a personal computer, warning signals throughout the call (col.40, line 55-col.41, line 10) and special parameters for a particular subscriber (col.15, lines 5-12). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Zicker into the system of Liao in order to provide a variety of mechanism for alerting the caller or recipient of the insecure nature.

5. Claims 13, 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liao et al (US 6,292,833).

As to claim 13, Liao teaches a method for providing secure transmissions in a telecommunications network on claim 4 above. Liao fails to teach that the system issues an alert when a previously secure route becomes insecure. However, it is obvious that when the network site is insecure, then the network site will be denied by the system and an alert message will be issued. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide alert message when a previously secure route becomes insecure into the system of Liao in order to alert the mobile user when a previously secure route becomes insecure

As to claims 30-31, Liao teaches the method of claim 25 wherein said alert is provided to a user of said sender and alert is provided to a user of said recipient (figure 5, steps 504-506), Liao fails to teach receiving authorization from said user, after said user has received said alert, to maintain a connection between said sender and said

recipient. However, receiving authorization from said user is obvious because the mobile still connects to the server which means he authorizes the connection otherwise he disconnects the phone. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the authorize connection from the user into the system of Liao in order to confirm the connection which may be intercepted by the unscrupulous.

6. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liao in view of Galvin (US 6,134,315).

As to claim 32, Liao teaches the method of claim 25. Liao fails to teach establishing a new route between said sender and said recipient. Galvin teaches routing system for provide routing between said sender and said recipient (col.4, lines 10-2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Galvin into the system of Liao in order to provide alternative new route between the mobile device and the network server.

Response to Arguments

7. Applicant's arguments filed 01/04/02 have been fully considered but they are not persuasive.

On claim 1 of page 8 of Applicant remarks, Applicant argues that Liao does not teach or suggest a network element ... transmitting a message ... indicating that a transmission was received Ever a non-private link subject to unauthorized interception.

In response, the examiner believes that on figure 1, Liao discloses the interface between Network Gateway (104) and mobile device is connected over the non private link (a public network, col.4, lines 27-37), Liao also discloses a transmission over a public network being intercepted or altered (col.6, lines 10-14).

On claim 4 of page 8 of Applicant remarks, Applicant argues that Liao does not teach or suggest the step of providing to the sender and prior to connection to the recipient an alert of the insecure nature of the transmission.

In response, the examiner believes that on figure 5, Liao teaches when the decision block determines that the connection is not secure, a secure indicator is reset 512 to insecure and forward message (warning or alert) to the requesting mobile device indicating the link is insecure prior connecting to the server (col.11, lines 13-40).

On claim 18 of page 9 of Applicant remarks, Applicant argues that Liao does not disclosed means for determining that an insecure link is used to establish a call path.

In response, the examiner does not believe that this argument is not in the claim.

Applicant also argues that Liao does not teach or suggest means for alerting the caller or called party when a call path is established using at least one insecure link.

In response, the examiner believes that on figure 5, Liao teaches a decision block 510 determines whether the connection being utilized is secure or insecure concerning the connection from the mobile device to the remote server or some portion thereof, when the decision block determines that the connection is not secure, a secure

indicator is reset 512 to insecure indicator and forward message to requesting mobile device indicating that the calling path is using at least one insecure link (col.11, lines 13-40).

On claim 25 of page 10 of Applicant remarks, Applicant argues that Liao does not claim 25.

In response, the examiner believes that Liao teaches a method for providing secure transmissions in a telecommunications network (figure 1) comprising the steps of:

establishing a route from a sender to a recipient (a router from mobile 102 to remote server 110);

determining whether at least a portion of the route includes a non-private link subject to unauthorized interception (a indicate message forward to the mobile device, step 516 of figure 5)

responsive to a positive result in said determining step, further determining whether a secure connection may be established between said sender and said recipient (a secure indicator message forward to requesting mobile device at steps 510, 514, 516 of figure 5); and

responsive to a positive result in said determining step and a negative result in said further determining step, providing an alert of the insecure nature of the route (a insecure indicator message forward to requesting mobile device step 512, 516 of figure 5).

8. Applicant's arguments with respect to claims 1-7, 10-14, 18-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C LE whose telephone number is 703-306-0542. The examiner can normally be reached on 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 703-308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-802-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Danh C.Le
March 17, 2002

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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